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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,046	01/13/2000	Antonio Gigola	6557	6489

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/31/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-5

**Office Action Summary**

Application No.

09/482,046

Applicant(s)

GIGOLA, ANTONIO

Examiner

Alicia Chevalier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II, claims 7-9 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that both recited process and article relates specifically to humidifying panels which require a plurality of non-rectilinear undulated panels to produce the necessary screening and humidifying features, and constitute a more complex and expensive manufacturing than simple cardboard which can be used for packing material, and wherein rectilinear channels are perfectly satisfactory for packing material. This is not found persuasive because the product as claimed can be made by a materially different process such as randomly pressing the undulated channels, i.e. not sequentially pressing.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

2. Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "in particular" in claim 7 is unclear which renders the claim vague and indefinite. The phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The phrase "by pressing with non-rectilinear undulated channels" in claim 7 is unclear which renders the claim vague and indefinite. The specifications and drawings show that the

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cardboard sheets are pressed with a heated die, where the die has an undulated/sinusoidal shape. The die imparts an undulated/sinusoidal shape into the individual sheets and when two of these sheets are arranged together with different mutual alternating undulation in contact, they form a channel. So, it is unclear how the cardboard sheets are being pressed with non-rectilinear undulated channels. Furthermore, since the channels are pressing the sheets it is unclear what the phrase “arranged with different mutual alternating inclination of channels” is really limiting since the only channels disclosed are in reference to the pressing means.

Claims 8 and 9 are unclear in scope, which renders the claims vague and indefinite. Claims 8 and 9 both further limit the “channel” of claim 7. Since the only channel recited in claim 7 is directed to the pressing means, “pressing with non-rectilinear undulated channels”, it is unclear whether Applicant is trying to further limit the screening panel or the means (apparatus) used to make the screening panel.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faigle (5,413,872) in view of Holmberg et al. (3,963,810).

Faigle discloses a filling member for use in cooling towers and heat exchangers comprising panel-like foils shaped in a wavy manner, comprising wave trough offset against

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wave crest, assembled to form flow ducts. The segments of two foils in the layering lying directly side-by-side and contacting each other are hermetically bonded or welded so that the individual flow ducts are peripherally closed across their entire course. See col. 2, lines 57-68, the abstract, and figure 2.

The filling member comprises ducts wherein each duct has end sections near the foil edges which constitute inlet and outlet sides of the member and which are virtually at a right angle to said edges and inclined sections for connection of said end sections. See figures 1 and 4.

Faigle discloses that the filling members can comprise mostly plastics materials, metals, glass or ceramics (col. 7, lines 29-32).

Faigle fails to disclose that the filling members are made of cardboard.

Holmberg discloses a contact body for use in cooling towers and heat exchangers comprising sinusoidal-shaped/corrugated contact plates made of metal, plastics, or impregnated cardboard (col. 1, lines 4-28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use impregnated cardboard as the material for the filling members in Faigle because Holmberg shows that plastics, metals, and impregnated cardboard are equivalent for their use in the art of cooling tower plates and the selection of any of these known equivalents would be within the level of ordinary skill in the art.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly

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different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation pressing with non-rectilinear undulated channels is a method of production and therefore does not determine the patentability of the product itself.

Faigle and Holmberg disclose all the limitations of the instant claimed invention except for wherein each channel has end sections near the sheet edges which will constitute inlet outlet sides of the panel and which are inclined with respect to said edges and sections virtually at a right angle to said edges and which are for connection of said end section.

Faigle further discloses that the flow ducts have two redirections in the flow direction. Several directions may be equipped to these flow channels so that they have a multiple sinuous, zig-zag or undulating course, wherein these flow ducts can extend in one plane, but also three-dimensionally (col. 3, lines 23-28 and figure 25). Further flow duct configurations can be seen in patents 3,111,982, 3,216,494, and 3,757,857.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape/configuration of the flow ducts. One skilled in the art would have been motivated to change the shape/configuration of the flow ducts depending on the how many times the user wants to redirect the flow and where the inlet and outlet flows are to be directed.

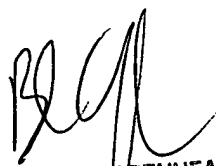
#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Blaine Copenheaver can be reached by dialing (703) 308-1261. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac  
12/21/01



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